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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/128,753 08/04/98 LIGHTCAP,

D DVL-003PAT

HM12/0921

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EXAMINER

PRYOR, A

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 09/21/01

*LS*

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/128,753

Applicant(s)

Lightcap et al

Examiner

Alton Pryor

Art Unit

1616



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jun 29, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-13, 15-43, and 45-47 is/are pending in the application.
- 4a) Of the above, claim(s) 34 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 33 and 36-41 is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-13, 15-27, 35, 42, and 43 is/are rejected.
- 7) ☒ Claim(s) 28-32 and 45-47 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other: \_\_\_\_\_

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- I. Rejection of claims 1-5,7-13,15-24 under 35 U.S.C. 103(a) will not be maintained in light of amendment filed 6/29/01. Applicant has replaced "comprising" by "consisting essentially of". The use of "consisting essentially of" removes detergents from the composition.
- II. Rejection of claims 1 and 22 under 35 U.S.C. 103(a) will not be maintained in light of amendment filed 6/29/01. See Roman Numeral I above.
- III. Rejection of claims 25-27 under 35 U.S.C. 103(a) will be maintained in light of amendment filed 6/29/01 for reason on record and as follows. In a claim drawn to a composition the intended use of the composition's individual components has no patentable significance. Therefore, a statement defining alkyl oxyalkylate as a foaming agent has no patentable weight. The combination of references result in a composition comprising alkyl oxyalkylate.
- IV. Rejection of claims 35,42-44 under 35 U.S.C. 103(a) will be maintained in light of amendment filed 6/29/01 for reasons on record and as follows. In the absence of unexpected results, the claims are not allowable. Applicant must show the criticality of 40-90% vegetable oil.

***Claim Rejection under 35 U.S.C. 112, 1st paragraph***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-5,7-13,15-24 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for instant emulsifiers, foaming agents, vegetable oils in instant specification, does not reasonably provide enablement for all other emulsifiers, foaming agents,

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and vegetable oils not disclosed in the instant specification. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make / use the invention commensurate in scope with these claims. Examiner suggests that applicant creates Markusk groups listing all of the emulsifiers, foaming agent, and vegetable oils disclosed in instant specification..

***Claim Objection / Allowable Subject Matter***

Claims 28-32,45-47 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 33,36-41 are allowable. For reasons on record. See paper no. 12.

***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton Pryor whose telephone number is (703) 308-4691. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees, can be reached on (703) 308-4628. The fax phone number for this Group is (703) 308-4556.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

A handwritten signature in black ink, appearing to read 'Alton Pryor', with a stylized flourish at the end.

Alton Pryor

Patent Examiner, AU 1616

9/20/01